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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,929	09/29/2003	Charles Whitaker	020375-032410	2374
20350 7590 03/04/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
RAPILLO, KRISTINE K				
ART UNIT		PAPER NUMBER		
3626				
MAIL DATE		DELIVERY MODE		
03/04/2009		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/675,929
Filing Date: September 29, 2003
Appellant(s): WHITAKER ET AL.

Irvin E. Branch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/30/2008 appealing from the Office action mailed 1/29/2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19 – 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under 35 USC § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2)

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transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 53, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC § 101 and is non-statutory subject matter. With regard to claim 19, the method claimed by the Applicant is not tied to another statutory class as it recites the limitations "receiving enrollment", "assigning an account", "assigning a code," and "producing a card". The method claimed does not include a particular machine, nor does it transform the data. The method steps recited in the body of claim 19 could reasonably be interpreted to encompass a human being performing these steps. Claims 20 and 21 are dependent on claim 19, and are therefore rejected using the same rationale.

The above deficiency can be overcome by expressly stating in the body of the claimed method, using a computer (apparatus) or terminal, for example, which makes the claim useful.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,012,035	Freeman et al.	01-2000
4,491,725	Pritchard	01-1985
5,070,452	Doyle et al.	12-1991
6,108,641	Kenna et al.	08-2000

<http://web.archive.org/web/20010609222540/www.gemplus.com/app/health/index.htm>

"New card to aid the sick: Onecare will store health, credit data." Brigitte Maxey. The Sun. Baltimore, Md.: Dec 16, 1991.

"MCI to provide backbone for Smart Card health care claims processing." Communications Today. Potomac: Dec 11, 1997. pg. 1.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19 – 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under 35 USC § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 53, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC § 101 and is non-statutory subject matter. With regard to claim 19, the method claimed by the Applicant is not tied to another statutory class as it recites the limitations "receiving enrollment", "assigning an account", "assigning a code," and "producing a card". The method claimed does not include a particular machine, nor does it transform the data. The method steps recited in the body of claim 19 could reasonably be interpreted to encompass a human being performing these steps. Claims 20 and 21 are dependent on claim 19, and are therefore rejected using the same rationale.

2. The above deficiency can be overcome by expressly stating in the body of the claimed method, using a computer (apparatus) or terminal, for example, which makes the claim useful.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1 – 9, 11 – 12, 14 – 16, and 22 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (U.S. Patent No. 6,012,035) in view of Pritchard (U.S. Patent No. 4,491,725).

As per claim 1, Freeman et al. teaches a method of verifying insurance coverage relating to a member comprising: searching a database to determine if the member identifier is valid (column 7, lines 20 – 25) and transmitting from the financial transaction processing computer system authorization information (column 5, lines 14 – 24 and column 7, lines 60 – 63). Freeman et al. discloses a loop system in Figure 1 which illustrates the method of all terminals (i.e. computer systems) having the ability to communicate to each other. Thus, a financial transaction processing computer system can provide authorization information.

Freeman et al. fails to teach receiving a member identifier at a computer system.

Pritchard teaches a method of receiving at a financial transaction processing system a member identifier relating to the member (column 7, lines 20 – 27). Pritchard describes a method in which an insurance card is verified against a master list using a local terminal that can be linked to a central computer (Figure 1). Pritchard also indicates that a service provider (i.e. physician) can contact a financial institution directly, therefore, member identification is performed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a computer processing system in which a member identifier is received as taught by Pritchard with the motivation of ensuring a person/member is covered by a valid insurance policy (column 7, lines 28 – 33).

As per claim 2, Freeman et al. teaches a method wherein the financial transaction processing computer system comprises a credit card processing system (column 7, lines 66 – 67 and column 8, line 1). This is accomplished through a 'swipe' through a credit card type machine.

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Regarding claim 3, Freeman et al. and Pritchard teach a method of verifying insurance via a database search and transmitting authorization information as per claim 1.

Freeman et al. fails to teach a method wherein the member identity number is in credit card number format.

Pritchard teaches a method in which the member identifier is received in credit card number format (column 5, lines 25 – 32 and column 5, lines 67 through column 6, lines 1 – 4). Pritchard describes an invention in which the member is assigned a number, which can be correlated to a credit card number format since credit card numbers are available in various formats.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a member identity number in credit card number format as taught by Pritchard with the motivation of providing more information storage and security (column 5, lines 40 – 66).

As per claim 4, Freeman et al. teaches a method further comprising receiving an individual code at the financial transaction processing computer system (column 5, lines 35 – 39).

Regarding claim 5, Freeman teaches a method as per claim 4, where the individual code is received in a format relating to currency (column 5, lines 35 – 39). Individual codes are available, however, unable to locate a format relating to currency specifically, other than for a financial institution. The examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention.

Regarding claim 6, Freeman et al. teaches a method as per claim 1, where in the insurance coverage relates to medical insurance (column 6, lines 59 – 62).

Regarding claim 7, Freeman et al. and Pritchard teach a method comprising receiving at the financial transaction processing computer system an identifier relating to a provider (column 5, lines 31 –

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35). Freeman et al. discloses a method in which cooperative members are provided identification in order to access a database. The cooperative members consist of buyers and sellers of healthcare products and services including health care providers, employees, employers, insurance companies, and financial organizations.

Regarding claim 8, Freeman et al. teaches a method as per claim 1 further comprising determining whether the provider is a network provider (column 4, lines 47 – 58). A network is described as a group in which various health care providers have agreed to join.

Regarding claim 9, Freeman et al. and Pritchard teach a method of verifying insurance as per claim 1.

Freeman et al. fails to teach a method indicating a denial of insurance coverage.

Pritchard teaches a method wherein the authorization information indicates a denial of coverage (column 7, lines 26 – 28 and lines 33 – 36).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method for rapidly indicating the status of insurance coverage as taught by Pritchard with the motivation of ensuring an individual is covered by a valid insurance policy (column 12, lines 9 – 11).

Regarding claim 11, Freeman et al. teaches a method of verifying insurance coverage relating to a member comprising entering member identifier information into a credit card processing device (column 7, lines 66 – 67 through column 8, line 1) and transmitting information to a host computer system (column 5, lines 14 – 26).

Freeman et al. fails to teach a method of receiving authorization information at a processing device.

Pritchard teaches a method of receiving authorization information at the processing device indicating whether the member has insurance coverage (column 7, lines 20 – 24).

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The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9, and incorporated herein.

Regarding claim 12, Freeman et al. teaches a method as per claim 11 wherein the identifier information comprises an individual code in a currency field (column 5, lines 35 – 39). The examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention.

Regarding claim 14, Freeman et al. and Pritchard teach a method of verifying insurance coverage as per claim 11.

Freeman et al. fails to teach a method where authorization can include a denial in insurance coverage.

Pritchard teaches a system wherein the authorization information indicates a denial of coverage (column 7, lines 26 – 28 and lines 33 – 36).

The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9.

Regarding claim 15, Freeman et al. teaches a method as per claim 1 wherein entering member identifier information comprises swiping an insurance card (column 6, lines 65 – 67).

Regarding claim 16, Freeman et al. teaches a method of swiping an insurance card as per claim 15.

Freeman et al. fails to teach a method the insurance card is made of credit card stock.

Pritchard teaches a method wherein the insurance card comprises credit card stock (column 5, lines 19 – 22). Pritchard describes a typical credit card, made of credit card stock (i.e. plastic), including a magnetic stripe on the back.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method in which the insurance card is made of credit card stock as taught by Pritchard with the motivation of providing an insurance card with the capability of storing secure information (column 5, lines 40 – 65).

Regarding claim 22, Freeman et al. teaches a system for processing insurance information comprising a credit card processing network (column 6, lines 66 – 67) which can include computer terminals, a host computer system (column 4, lines 26 – 30) and wherein the host computer system is programmed to receive information from a point of sale device via the credit card processing network and verify coverage (column 2, lines 51 – 55 and column 8, lines 1 - 7).

Regarding claim 23, Freeman et al. and Pritchard teach a system as per claim 22, wherein the host computer system is further programmed to determine a dependent's coverage (column 7, lines 20 – 25). The reference describes a method for providing verification of a patient's eligibility. The examiner interprets this to include all patients therefore patient eligibility can refer to all members covered by the insurance plan.

Regarding claim 24, Freeman et al. teaches a system as per claim 22 wherein the host computer system is programmed to determine if a provider is a network provider (column 4, lines 47 – 58). A network is described as a group in which various health care providers have agreed to join.

Regarding claim 25, Freeman et al. teaches a system as per claim 22.

Freeman et al. fails to teach the transmittal of an approval code.

Pritchard teaches a system wherein the host computer system is further programmed to transmit an approval code (column 7, lines 26 – 36).

The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9.

Regarding claim 27, Freeman et al. teaches a system for processing insurance information.

Freeman et al. fails to teach the approval code can be a denial of coverage.

Pritchard teaches a system wherein the approval code comprises a denial of coverage (column 7, lines 26 – 28 and 33 – 36).

The motivation for combining the teachings of Freeman et al. and Pritchard is discussed in the rejection of claim 9.

5. Claims 10, 13, 19 – 20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. in view of Pritchard, as applied to claims 1 and 11, and in further view of Doyle et al. (U.S. Patent No. 5,070,452).

Regarding claims 10 and 13, Freeman et al. and Pritchard teach a method of verifying insurance coverage as per claim 1.

Freeman et al. and Pritchard do not teach a system where authorization can signal a co-pay.

Doyle et al. teaches a system wherein the authorization information comprises a co-payment (column 5, lines 54 – 62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system for co-pay authorization as taught by Doyle et al. with the motivation of updating a physicians records and receiving payment at the time of medical service (column 8, lines 64 – 66 and column 9, lines 4 – 7).

Regarding claim 19, Freeman et al. teaches a method of enrolling a member into medical coverage comprising receiving enrollment information from the member (column 5, lines 64 – 67).

Freeman et al. does not explicitly teach a method of assigning an account number, assigning codes to dependents covered under the insurance, or producing a card for the member.

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Pritchard teaches a method of assigning an account to the member wherein the account is in a credit card format (column 5, lines 25 – 32) and producing a card for the member wherein the card comprises credit card stock (column 5, lines 19 – 22).

Pritchard fails to teach a method of assigning codes to dependents covered under the insurance.

Doyle et al. teaches a method of assigning a code to each covered dependent of the member wherein each dependent's code is in currency format (column 4, lines 11 – 16). The examiner interprets the code in currency format to represent a symbol relating to the individual covered by insurance, and not a mathematical or financial transaction. Letters, numbers, symbols, or any combination may replace the currency format thereof without changing the scope of the invention.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of assigning codes to dependent covered under the insurance plan as taught by Doyle et al. with the motivation of providing identification of the patient in order to assure the actual patient enrolled in the insurance plan is receiving the treatment (column 4, lines 17 – 20).

Regarding claim 20, Freeman et al., Pritchard, and Doyle et al. teach a method of enrolling a member into medical coverage as per claim 1.

Freeman et al. and Pritchard do not teach a method to produce dependent codes on the insurance card.

Doyle et al. teaches a method as per claim 19 producing dependent codes on the card (column 4, lines 5 – 16). The insurance card includes a client code, which identifies the insurance plan, as well as the relationship to the cardholder.

The motivation of combining the teachings of Freeman et al., Pritchard, and Doyle et al. is discussed in the rejection of claim 19.

Regarding claim 26, Freeman et al. and Pritchard teach a system for processing insurance information as per claim 22.

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Freeman et al. and Pritchard do not teach a system where the approval code indicates a co-payment.

Doyle et al. teaches a system wherein the approval code comprises a co-payment (column 5, lines 54 – 62). The examiner interprets 'approval' to be equivalent to 'authorization'.

The motivation of combining the teachings of Freeman et al., Pritchard, and Doyle et al. is discussed in the rejection of claims 10 and 13.

6. Claims 17 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pritchard in view of Doyle et al.

Regarding claim 17, Pritchard discloses an insurance card comprising an account number in credit card number format (column 5, lines 25 – 32 and column 5, line 67 through column 6, line 4), a machine-readable storage medium (column 6, lines 4 - 7) and wherein the insurance card comprises credit card stock (column 5, lines 19 – 22).

Pritchard fails to teach a list of covered members.

Doyle et al. teaches a list of covered members (column 4, lines 11 – 16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a list of covered members as taught by Doyle et al. with the motivation of maintaining a comprehensive roster of all individuals actively covered under an insurance plan, including the types of benefits available (column 2, lines 4 – 10). This allows physicians to view what options for medical service are available for patients based on their insurance plans (i.e. what services are covered).

Regarding claim 18, Pritchard teaches an insurance card as per claim 17 wherein the insurance card relates to medical insurance (column 7, lines 10 – 12).

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7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. in view of Pritchard and Doyle et al., as applied to claim 20, and in further view of Kenna et al. (U.S. Patent No. 6,108,641).

Regarding claim 21, Freeman et al., Pritchard, and Doyle et al. teach a method of enrolling a member into medical coverage as per claim 19.

Freeman et al., Pritchard, and Doyle et al. do not teach pre-tax spending accounts.

Kenna et al. teaches a method comprising entering pre-tax spending account information relating to the member (column 2, lines 62 – 65 and column 8, lines 56 – 59).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include pre-tax spending accounts as taught by Kenna et al. with the motivation of tracking medical expenses and deposits via a link to the medical savings account database, as well as the insurance provider database (column 3, lines 44 – 52).

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(10) Response to Argument

In the appeal brief filed 6/30/2008, Appellant makes the following arguments:

Issue 1

(A) The Examiner fails to establish a prima facie case of obviousness.

(B) The Freeman and Pritchard references, with regard to claim 1, fail to teach or suggest "receiving at a financial transaction processing computer system a member identifier relating to the member"; "transmitting from the financial processing computer system authorization information"; or "a financial transaction processing computer".

(C) The Freeman reference does not teach or suggest "wherein the financial transaction processing computer system comprises a credit card processing machine."

(D) The Pritchard reference does not teach or suggest wherein the member identifier is received in credit card format.

(E) The Freeman reference does not teach or suggest that the individual code is received in a format relating to currency.

(F) The Freeman reference does not teach or suggest entering member information into a credit card processing device.

(G) The Freeman reference does not teach or suggest a host computer system that is programmed to receive insurance information from a point of sale device via the credit card processing network and verify coverage.

Issue 2

(H) The Examiner does not give patentable weight to the currency format element.

Issue 3

(I) The Pritchard reference does not teach or suggest an insurance card having an account number in credit card format and a list of covered members.

Examiner will address Appellant's arguments in sequences as they appear in brief.

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Response to Issue 1

(A) The Appellants maintain the rejection of claim 1 is improper because the record has not established a *prima facie* case of obviousness. The Examiner respectfully submits that establishing a *prima facie* case of obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and motivations for combinations that fairly suggest Applicant's claimed invention (see: paper dated 1/29/08).

In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

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References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the prior Office Action (see: paper dated 1/29/08), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

(B) In regard to claim 1, the Appellant argues that the cited references do not teach or suggest "receiving at a financial transaction processing computer system a member identifier relating to the member"; "transmitting from the financial processing computer system authorization information"; or "a financial transaction processing computer". The Examiner respectfully disagrees.

The Examiner respectfully submits that Freeman discloses a method of transmitting from the financial processing computer system authorization information (Freeman: column 7, line 54 through column 8, line 7) where a bank provides a member (i.e. patient) an electronic card; the patient presents the electronic card to the physician who can swipe the card through a credit card machine and receive eligibility and verification information from a bank terminal. Thus, the electronic card used in conjunction with a credit card machine transmits and authorizes service and coverage. This suggests transmitting authorization from a financial transaction processing computer.

To further support the Examiner's interpretation, the Examiner respectfully submits that Pritchard discloses a central brokerage computer which serves to provide fund transfer (Pritchard: column 4, lines 56 – 64) and can be used as a central computer capable of sending and receiving communications and where the brokerage computer can be used as an agent for all parties involved to carry out fund transfer (Pritchard: column 4, lines 54 – 64). Pritchard discloses a method of receiving at a financial transaction processing computer a member identifier relating to the member (Pritchard: column 7, lines 20 – 27).

Thus, the proper combination of the applied references would be the incorporation of Pritchard's system for the transferring of funds (i.e. financial transaction processing computer) within the system and method for member identification and eligibility, including credit status, as taught by Freeman.

(C) In regard to claim 2, the Appellant argues the cited references do not teach or suggest "wherein the financial transaction processing computer system comprises a credit card processing machine." The Examiner respectfully disagrees. The Appellant discloses in the specification that a financial transaction processing computer is a credit card processing machine (Appellant: paragraph [0015]) which transmits information to a host computer for insurance verification (Appellant: paragraph [0008]). Freeman reads on the Appellant's invention by disclosing a credit card type machine in which a physician may swipe a patient's card. This information is sent to the bank (i.e. financial institution) via the data switch and repository (which is the central computer – Freeman: column 2, lines 7 – 25 and column 5, lines 15 - 26) to verify eligibility through collaboration with insurance companies (Freeman: column 7, line 66 through column 8, line 7).

(D) In regard to claim 3, the Appellant argues that the cited references do not teach or suggest wherein the member identifier is received in credit card format. The Examiner respectfully disagrees. The Appellant discloses in the specification that the credit card format is an account number that relates the member to the information stored in the database (Appellant: paragraph [0044]). Pritchard teaches an invention in which the member is assigned an identification number (Pritchard: column 5, lines 25 - 32 and column 5, line 67 through column 6, line 4) which can be correlated to a credit card format (i.e. number) since credit card number/formats are available in various formats. Figure 2 of Pritchard illustrates an electronic card with an account or identification number located on the card.

(E) In regard to claim 5, the Appellant argues that the cited references do not teach or suggest that the individual code is received in a format relating to currency. The Examiner respectfully disagrees. The Appellant discloses in the specification the format may be in currency format (paragraphs [0004], [0005], and [0007] of the Appellant's specification). The Examiner interprets this to mean the code does not have to be currency format. Freeman teaches a method in which individual codes are assigned (Freeman: column 5, lines 35 – 39). Freeman does not explicitly teach a format relating to currency, however, the format is irrelevant as the currency symbol used is nothing more than a symbol identifying an individual covered by insurance. Letters, numbers, symbols, or any combination thereof may replace the currency format without changing the scope of the invention.

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(F) In regard to claim 11, the Appellant argues that the cited references do not teach or suggest entering member information into a credit card processing device. The Examiner respectfully disagrees. Freeman teaches entering information into a credit card processing device (Freeman: column 7, line 66 through column 8, line 1) where the provider has the option of swiping or manually entering the account or card number. In addition, Freeman discloses the option of telephoning the number in (Freeman: column 6, lines 65 - 67).

(G) In regard to claim 22, the Appellant argues that the cited references do not teach or suggest a host computer system that is programmed to receive insurance information from a point of sale device via the credit card processing network and verify coverage. The Examiner respectfully disagrees. Freeman teaches a system for processing insurance information comprising a credit card processing network (Freeman: column 6, lines 66 - 67) which can include computer terminals, a host computer system (Freeman: column 4, lines 26 - 30; described as a data switch and repository in Freeman) and wherein the host computer system is programmed to receive information from a point of sale device via the credit card processing network and verify coverage (Freeman: column 2, lines 51 - 55 and column 8, lines 1 - 7).

Response to Issue 2

(H) In regard to claim 19, the Appellant argues that the Examiner does not give patentable weight to the currency format element. The Appellant discloses in the specification the format may be in currency format (paragraphs [0004], [0005], and [0007] of the Appellant's specification). The Examiner interprets this to mean the code does not have to be currency format. Freeman teaches a method in which individual codes are assigned (Freeman: column 5, lines 35 - 39). Freeman does not explicitly teach a format relating to currency, however, the format is irrelevant as the currency symbol used is nothing more than a symbol identifying an individual covered by insurance. Letters, numbers, symbols, or any combination thereof may replace the currency format without changing the scope of the invention.

Response to Issue 3

(I) In regard to claim 17, the Appellant argues that the cited references do not teach or suggest an insurance card having an account number in credit card format and a list of covered members. The Examiner respectfully disagrees. The Appellant discloses in the specification that the credit card format is an account number that relates the member to the information stored in the database (Appellant: paragraph [0044]). Pritchard discloses an insurance card comprising an account number in credit card format (Pritchard: column 5, lines 25 - 32 and column 5, line 67 through column 6, line 4) which can be correlated to a credit card format (i.e. number) since credit card number/formats are available in various forms. Figure 2 of Pritchard illustrates an electronic card with an account or identification number located on the card.

Pritchard fails to teach a list of coverer members. Doyle teaches a list of covered members (Doyle: column 4, lines 11 - 16). Doyle discloses that a card holder (i.e. patient) brings his card to a provider site and the card is read by a computer. The Examiner interprets this to be a list of covered members in that the card holder is the patient (therefore, it could be a spouse or dependent) thus each patient would have a card. Additionally, if the card is comprised of a computer readable medium, swiping or entering the card number (account or member identification) would list all of the covered members of the account (Doyle: column 2, lines 45 - 51 and column 6, lines 18 - 30).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any

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amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Kristine K Rapillo/

Examiner, Art Unit 3626

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/

Director, TC 3600

Conferees:

/Robert Morgan/

Primary Examiner, Art Unit 3626

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Tech Center 3600

Vincent Millin /vm/

Appeals Conference Specialist

Tech Center 3600